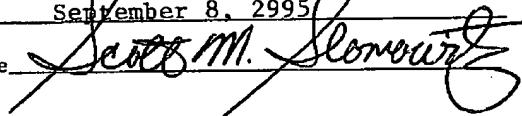


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) M1043/20006	
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		First Named Inventor Edward M. Moll	
		Art Unit 2636	Examiner John A. Tweel, Jr.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record.

Registration number 39,032

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

September 8, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PATENT EXAMINING OPERATION

Applicant: Edward M. MOLL

Serial No: 08/835,625

Group Art Unit: 2636

Filed: April 9, 1997

Examiner: John A. Tweel, Jr.

Att. Docket No.: M1043/20006

Confirmation No.: 5281

For: THOUGHT CONTROLLED SYSTEM

REMARKS/ARGUMENTS IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Final Rejection dated, June 15, 2005, Applicant requests this pre-appeal brief request.

Errors In the Examiner's Rejection

## 1) Examiner's Omissions of One or More Essential Elements Needed for a Prima Facie Rejection

The Examiner has maintained his §103(a) rejection of Claims 1, 4, 9, 12, 15, 17, 21, 38, 40, 51, 55 and 67-70 based on U.S. Patent No. 5,474,082 (Junker) in view of Smotroff (Business Wire). Per page 2 of the Final Rejection and per page 3 of the previous Office Action (dated September 29, 2004), the Examiner asserts that Junker includes all of the limitations of Claim 1 except for the identification means that compares stimuli to stored stimuli. To make up for the identification means deficiency, the Examiner cites Smotroff.

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However, one of the elements specified in Claim 1, is (b)(1) function selection means. The Examiner's rejection on page 2 of the Final Rejection and on page 3 of the previous Office Action states that Junker includes "...3) the claimed function selection means..." thereby asserting that Junker teaches the claimed function selection means;. As to Junker, the Board clearly stated in its opinion of March 31, 2004:

Appellant argues at page 17 et seq. of the brief that the function selection means and the identification means are not taught or suggested by Junker. We agree with appellant, and do not find that the examiner has shown where or how Junker teaches these claim limitations. (emphasis added, p. 5, Board of Patent Appeals and Interferences).

Thus, in the Final Rejection (and the previous Office Action), the Examiner is still relying on Junker, alone, as teaching the function selection means in disregard of the Board's conclusion; combining Junker with Smotroff does not make up for the function selection means deficiency. Therefore, even if one skilled in the art were to combine Junker with Smotroff, the result would still not be the inventions of the rejected claims (see Applicant's February 14, 2005 response, p. 10, for more detail).

## 2) Clear Error in the Examiner's Rejections

The Examiner has taken a one page product announcement, Smotroff, for the computer game "MindDrive" and extrapolated from that announcement what he considers sufficient technical detail to make up for the deficiencies of Junker to obviate the claims of the present invention. However, as was stated in Applicant's February 14, 2005 response at pages 10-11, Smotroff is not a specification; it's just a business wire article for the MindDrive computer game. Applicant then

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informed the Examiner that the MindDrive computer game literature cites U.S. Patent No. 5,016,213 (Dilts, et al.) which provides a technical explanation of how the MindDrive concept works.

Applicant then provided technical distinctions on pages 11-14 (February 14, 2005 response) as to how U.S. Patent No. 5,016,213 (Dilts, et al.), and therefore, by implication Smotroff, has no capability nor suggestion for pre-storing biological states or even pre-storing electrodermal stimuli or to even relate to specific electrodermal states in order to identify specific thoughts.

The Examiner provided no substantive response or rebuttal to these technical distinctions in the Final Rejection other than to say, "Just because the Applicant cited the Smotroff reference in an earlier Information Disclosure Statement and the Background cites the Dilts patent does not make it any less of a relevant reference, especially when properly combined with the prior art above." See Response to Argument 2 (page 14 of Final Rejection). However, pages 11-14 of Applicant's February 14, 2005 provides an overabundance of reasons why Smotroff even if combined with Junker still does not teach nor suggest the present invention. In particular, the Examiner is asserting Smotroff for the concept of "compares brain stimuli to stored stimuli and performs the corresponding function." (page 3, line 16 of Final Rejection and page 4, line 7 of the previous Office Action); however, Applicant has countered that Dilts, and by implication Smotroff, has no capability nor suggestion to pre-store biological states or even pre-store electrodermal stimuli or even relate to specific electrodermal states in order to identify specific thoughts (page 12, lines 18-21 of February 14, 2005 response) and cited Dilts, col. 6, lines 31-33. The Examiner's only response to that is that he is quite amused by this particular statement. See Response to Argument 3 (page 14, line 12 of

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Final Rejection). The Examiner then refuses to even address Dilts et al. (which is Smotroff) and then argues that Junker plainly recites the storing digital brain-body signals in a memory store, alluding to the function selection means of Claim 1 of the present invention. See Response to Argument 4 and to Argument 7 (page 15, lines 2 and 12 of Final Rejection). But, as stated previously on page 2 of this Pre-Appeal Brief Request, the Board previously concluded that Junker cannot be cited for disclosing Applicant's Claim 1 (b)(1) the "function selection means which comprises a memory including a correspondence between a plurality of previously-stored user stimuli and a plurality of desired function control signals."

The Examiner asserts that the claims omit any recitation to time delay or time rate of change the rejections are proper (Response to Argument 5, page 15 of Final Rejection). However, the Examiner is missing the point that Dilts, and by implication Smotroff, operates off of the time rate of change of the skin-sensed signal (see page 12, lines 6-12 and 19-23 of February 14, 2005 response). This indicates that Smotroff cannot be "comparing brain stimuli to stored stimuli and performs the corresponding function" which is the feature that the Examiner is citing Smotroff for in the first place (see page 3, line 16 of the Final Rejection).

The Examiner asserts that the despite what Smotroff states in particular, finger sensors are well-known for measuring heart rate, temperature, and blood pressure (Response to Argument 6, page 15 of Final Rejection). But again, the Examiner misses the point. The detection of heart rate, temperature, blood pressure, etc., are similar to detecting electrodermal responses and that the cause of these is not fully understood (Dilts, col. 1, lines 22-25; see pages 13-14 of February 14, 2005

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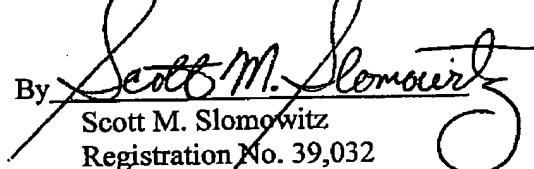
response). As a result, this rebuts the Examiner's characterization of Smotroff (page 3, Final Rejection and page 3 previous Office Action) that the MindDrive software "recognizes the distinctive signals produced by different mental activity and that the computer stores "stimuli patterns" and that "the control functions are enacted based on the previously observed stimulus." (See page 14, lines 23-26 of February 14, 2005 response).

Thus, for all of these reasons, Applicant respectfully submits that Claims 1-2, 4, 9, 12, 15, 17-18, 21, 38, 40, 44-45, 51, 55 and 67-70 distinguish over the art of record and are patentable thereover. For at least the reasons set forth above, and in the February 14, 2005 response, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,  
COHEN & POKOTILOW, LTD.

By

  
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September 8, 2005

Please charge or credit our Account  
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